REMARKS

Claims 11-29 and 37-44 are presently pending in the application. Claims 11, 13-18, 21, 23-25, 27, 37-44 have been amended. In the Office Action dated January 30, 2004, claims 11-13, 16-24, 27-29, 37-39, and 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,067,561, to Dillon in view of U.S. Patent No. 6,275,848, to Arnold, and claims 23, 24, 27-29, 37-39 and 41-43 were rejected for similar reasons. Claims 14, 15, 25, 40 and 44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dillon in view of Arnold and further in view of U.S. Patent No. 6,311,210, to Foladare et al. ("Foladare"), and claims 25, 40 and 44 were rejected for similar reasons. Claim 26 was rejected under § 103(a) as being unpatentable over Dillon in view of Arnold and further in view of U.S. Patent No. 5,632,011, to Landfield et al. ("Landfield").

Applicant disagrees with these grounds of rejection and wishes to clarify various distinctions of applicant's invention over the cited art. Reconsideration is therefore requested in light of the following remarks.

Summary of Interview

As an initial matter, Applicant thanks Examiner England and Supervisor Jaroenchonwanit for participating in the telephonic interview of May 24, 2004. In that interview, the undersigned attorney explained the differences between the claimed invention and the cited art. It was agreed that if an amendment were filed with an RCE application clarifying that the acts of receiving an indication of multiple recipients for an Email communication and the conditional storing of a single copy of the Email communication on a server based on whether the Email communication was designated for multiple users or not, were acts that were performed by Email communication program, then the claimed invention would be allowable over the art of record. The present amendment to the claims conforms to the Examiner's indication in this regard.

Applicant's Teaching in Comparison to the Cited Art

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define

the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

Applicant discloses a method and system for securely distributing an electronic message (*i.e.*, electronic communication) to multiple individual recipients in an efficient manner using centralized storage and management. In particular, the method involves receiving an electronic message containing an indication of the recipient(s) for the message, and makes a determination whether the indication is for multiple recipients. Unlike conventional methods, the present method uses *an email communication program that makes a conditional decision that if the indication is for multiple recipients*, the program does not send the message to the recipients, but rather centrally stores the message on a server, and sends only a short notification of the message to each of the multiple recipients without sending the message itself. The program does not send the message to any recipient until it receives a response from at least one of the recipients that contains a request for the message. If the indication is not for multiple recipients the message is sent to the recipient without being stored. In various embodiments, the system tracks, tests and routes requests from the recipients to access the message when appropriate and deletes the stored message when all recipients have responded and therefore all have received the message, unless at least one recipient requests that message be saved.

Thus, a single copy of the message can be stored on a server computer for delivery on an individual basis to multiple recipients when requested. In various embodiments, the program (or computer system configured therewith), also stores instructions related to a particular recipient regarding the type of notification to be performed for that particular recipient, and sends the notification according to those instructions of that particular recipient In certain embodiments, the notification instructions are tailored by a particular recipient and in others, the notification instructions are automatically assigned for a particular recipient. In some cases the notification instructions indicate the message is to be encrypted, and the system performs the encryption accordingly. In certain embodiments, after all recipients have reviewed the message and no recipient has indicated a choice to save the message (or all have indicated a choice to delete the message) the system automatically deletes the single copy of the message. The instructions may include actions to be taken with respect to the message, such as to save or delete the message or to forward the message to another recipient. While a user may ultimately be the

source of the instructions, it is the Email communication program that performs the acts based on those instructions. Hence, the program performs these acts transparently to the user.

The centralized storage and management of electronic messages to be distributed to a large number of recipients provides a variety of benefits. Because only a short indicator is sent to each recipient, the recipient's systems require only a small amount of storage space. In addition, each recipient system does not need the necessary software to save and manage the electronic messages. Instead, the recipient system need only be able to display a message and to send requests and other message action instructions to the server. In addition, central storage of the message provides easy access and control of the original message by an appropriate authorized user who may need access to the centrally message for any number of reasons (*e.g.*, for backup, for authentication, or for modification). Removal or modification of the message to be distributed to a large number of users is therefore easily accomplished.

The cited prior art references, alone or in combination, fail to teach the combination of features of Applicant's invention in any manner that would fairly suggest or motivate one of ordinary skill in the art to create a message management system like Applicant's.

Dillon is directed to sending notifications (alerts) of Email messages to recipients using a hybrid network that transmits notifications via a continuous high speed channel. Other than these features and in particular, the features regarding how the alerts are sent, the handling of messages as taught by Dillon is conventional in the art. In this regard, Applicant respectfully submits that the Examiner has read more into Dillon than is taught therein and/or has not properly characterized the teaching of that reference, especially in comparison to Applicant's embodiments. In the Office Action the Examiner stated that Dillon teaches:

> If it is determined that multiple recipients have been indicated,   (ITEM 1)
>
> a.   storing the Email communication, (*e.g.*, col. 3, lines 12-65)   (ITEM 2)
>
> b.   notifying each of the multiple recipients of the Email to communication [sic]
>   without sending the Email communication to the recipients (*e.g.*, col. 1, line
>   25 – col. 2 line 38 and col 3., lines 12-65).   (ITEM 3)

This is not an accurate characterization of what is taught in the cited passages (or anywhere else) in Dillon.

First, and most importantly, Dillon does not teach *anything whatsoever* about storing an Email message *conditionally* based upon anything about the indication, (*i.e.*, **IF** it is determined that multiple recipients have been *indicated*). In this regard, the cited passages of Dillon at most teach storing an email message if the user has not accessed the Email account, not requested the Email, or is not online. This is common in the prior art. Nothing in Dillon, teaches determining *anything* about the *indication* sent to any recipient to make a conditional decision on whether to store the Email message. Therefore the conditional aspect of Item 1 above is not taught in Dillon.

Second, Dillon does not teach determining whether multiple recipients have been indicated. The Examiner seems to acknowledge this by stating that "Dillon does not specifically teach determining whether multiple recipients of the Email communication have been indicated in the received indication." Therefore, all of the elements of Item 1 are missing from Dillon.

Third, because Dillon is silent about indications of multiple recipients, it is axiomatic that Dillon does not teach "notifying *each of the multiple recipients* of the Email to communication [sic] without sending the Email communication to the recipients." Dillon makes no references at all to multiple recipients for the same Email communication. Therefore all the elements of Item 3 are missing from Dillon.

The only elements Dillon teaches that are relevant to Applicant's embodiments is Item 2, (storing an email message) and *part* of Item 3 (sending notification of the Email message to a recipient without sending the Email message). Accordingly, with all due respect, the Examiner's characterization of the elements taught by Dillon is not accurate. With respect to the Items above, Dillon at most teaches storing an email message and sending a notification of the message to a recipient , *e.g.*, "You've got mail. " Any prior art Email system does this.

The deficiency of Dillon is not cured by combination with Arnold. Arnold was cited for teaching "determining whether multiple recipients of the Email communication have been indicated in the received indication. (col 4, lines 25-col. 5, line 25)." Applicant acknowledges that Arnold teaches determining whether multiple recipients of the Email communication have been indicated. However, Arnold does not teach storing the Email message conditionally, based upon whether multiple recipients have been indicated. Indeed, Arnold teaches nothing at all about treating the Email message differently based upon whether multiple

recipients have been indicated. What Arnold teaches at the cited passages and elsewhere, is detaching attachments from Email messages based on size (or other criteria), storing the attachment on the Internet, sending all the designated recipients the Email message devoid of the attachment, but with an embedded URL link, and allowing the recipients access to the stored attachment through the link embedded in the Email message. These features are not conditionally based on whether multiple users have been indicated or not.

Accordingly, the combination of Arnold with Dillon fails to teach or suggest the combination of elements in the various embodiments disclosed by Applicant.

In addition, the motivation for combining Arnold with Dillon stated by the Examiner is not understood by the undersigned, and in any case is not relevant because the combination would not lead one of skill in the art to devise a method like Applicants. The motivation for combining the references stated by the Examiner is "because it would be more efficient for a system to acknowledge when multiple recipients have been indicated so if the sender needed to know which recipients did not receive an Email, the sender could resend the Email to the recipients that are missing the Email or have misplaced it." The undersigned respectfully submits that this is motivation created by the Examiner, not derived from the references, because no such features are taught, suggested, or stated to be desirable in the systems described by Arnold and Dillon. Neither reference discusses efficiency based on whether multiple recipients have been indicated or resending Email to recipients that are missing or have misplaced the Email. These advantages are however, a benefit of Applicant's invention. It is impermissible hindsight to read the prior art in light of the disclosed invention to find a motivation in the prior art to do what Applicant has done.

Moreover, even if one would combine Arnold and Dillon for other reasons, these reasons are not relevant to Applicant's invention nor would they lead one of ordinary skill in the art to the same. Dillon is directed toward sending notifications (alerts) of Email messages to recipients using a hybrid network that transmits notifications via a continuous high speed channel, while Arnold is directed toward a method of detaching attachments from Email messages, storing the attachments on the Internet and sending a notification message with an embedded URL address for the stored attachment to the recipients. The combination of Arnold and Dillon might provide motivation to one of ordinary skill in the art to send notifications

devoid of attachments described by Arnold using the continuous high speed channel taught by Dillon. This is not relevant to, and does not suggest, storing email messages conditionally based on whether there is an indication of multiple users. Therefore, even accepting the proposed motivation asserted by the Examiner, the combination of references would not yield the system described by Applicant.

The Claims and Rejections

Rejections under § 103. Turning now to the claims and the rejections thereof, each of amended base claims 11, 37 and 41 recite, in pertinent form, *providing an Email communication program on a server* that performs the acts of receiving an indication of an Email communication that includes an indication of designated recipients and determining whether multiple recipients of the Email communication have been indicated in the received indication; and *if it is determined that multiple recipients have been indicated, storing the Email communication on the server and; notifying each of the multiple recipients of the Email communication without sending the Email communication to the recipients.* As discussed above, this type of conditional determination of whether or not to store an Email message based on whether or not multiple recipients have been indicated is not taught or suggested by earthier Dillon or Arnold, the primary references cited by the Examiner. Further to the interview, the amendment to the claims makes clear the receipt of the indication of multiple recipients, the determination of whether multiple recipients are indicated and the conditional storage of a single copy of the Email message on a server are all acts performed by the Email communication program.

As discussed in the interview, the core aspect of Applicant's invention is a computer program that automatically makes the conditional determination based whether to store the email communication in a single location IF the email communication is designated for more than one user. Dillon does not teach this type of conditional determination, nor does Arnold. Arnold teaches making the conditional decision whether to store the email communication based on the size of the email attachment, not whether the email is indicated for multiple recipients.

Therefore, Applicant requests withdrawal of the rejection of the base claims 11, 37 and 41 on grounds of obviousness over Dillon and Arnold.

Each of the remaining claims 12-29, 38-40 and 42-44 have also been amended to clarify that the Email program performs the recited acts. These claims each depend from an allowable base claim and are patentable at least for that reason. Applicant therefore also requests withdrawal of the rejections of these claims on grounds of obviousness. This is not an admission that patentability of any of these dependent claims rises and falls with the independent claims. Rather this expedient is used herein in the interest of brevity. Applicant reserves the right to further distinguish the dependent claims over Dillon, Arnold, Foladare and Landfield at a later time if necessary.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosures:
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    Check
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